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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,434	06/09/2000	Dean F. Jerding	A-6594	1996
5642 7590 05/28/2008 SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044				
EXAMINER ANDRAMUNO, FRANKLIN S				
ART UNIT 2623		PAPER NUMBER		
NOTIFICATION DATE 05/28/2008		DELIVERY MODE ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN F. JERDING, ROBERT O. BANKER, ARTURO A.
RODRIGUEZ, VALERIE GREW GUTKNECHT, and SHASHI GOEL

Appeal 2007-3779
Application 09/590,434
Technology Center 2600

Decided: May 23, 2008

Before JOHN A. JEFFERY, CARLA M. KRIVAK, and KEVIN F.
TURNER *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of
claims 134-138. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF CASE

Appellants' claimed invention provides a television set-top terminal (STT) that receives media guide data for on-demand rental video presentations that include control options allowing the user to choose between rental options (cl. 134; Abstract).

Independent claim 134, reproduced below, is representative of the subject matter on appeal.

134. A television set-top terminal ("STT") coupled to a server via a bi-directional communication network, said STT comprising:

memory having at least one program code stored therein;

at least one processor that is programmed by the program code to enable the STT to:

receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations;

provide a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion of the media guide data corresponding to a plurality of on-demand rentable video presentations;

responsive to presentation specific rent flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation;

configure a first rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation of the user-selected on-demand rentable video presentation;

configure a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation;

receive a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation;

provide the first rental option and the second rental option to the user responsive to the first user input;

receive a second user input responsive to providing the first rental option and the second rental option;

provide the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding movie trailers responsive to the second user input corresponding to the selection of the first rental option and the second rental option; and

suspend the provision of the rentable video presentation and provide the user with suspension promotional advertising responsive to third user input, wherein the suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the presentation and independent of the first rental option and the second rental option.

REFERENCES

Neel	US 5,838,314	Nov. 17, 1998
Matthews	US 5,914,746	Jun. 22, 1999
Kikinis	US 5,929,849	Jul. 27, 1999
White	US 6,628,302 B2	Sep. 30, 2003

Bee, Dixie Reid "Coming Attractions Before They Hit the Big Screen, Most Films Begin Life as a Trailer," The Sacramento Bee, July 18, 1996, p. E1

The Examiner rejected the claims as follows:

1. claim 134 under 35 U.S.C. § 103(a) based upon the teachings of White, Neel and Bee;
2. claim 135 under 35 U.S.C. § 103(a) based upon the teachings of White, Neel, Bee, and Matthews; and
3. claims 136-138 under 35 U.S.C. § 103(a) based upon the teachings of White, Neel, Bee, Matthews, and Kikinis.

Appellants contend that none of the references, alone or combined, teaches or suggests an STT that includes a first rental option to view a selected on-demand video presentation without promotional advertising or a second rental option without preceding movie trailers (Br 7; Reply Br. 4).

ISSUES

Did the Examiner err in rejecting claim 134 under 35 U.S.C. § 103(a) as obvious over White, Neel, and Bee? Did the Examiner err in rejecting claim 135 under 35 U.S.C. § 103(a) as obvious over White, Neel, Bee, and Matthews? Did the Examiner err in rejecting claims 136-138 under 35 U.S.C. § 103(a) as obvious over White, Neel, Bee, Matthews and Kikinis?

FINDINGS OF FACT

1. Appellants' invention is a television set-top terminal (STT) that allows a user a first rental option to view a selected "on-demand rental video presentation without presentation of promotional advertising that is otherwise shown" (cl. 134) or a second rental option to view a selected "on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation" (cl. 134).

2. White teaches interactive video programming methods that permit a user to search a database of available videos and other advertising (col. 4, ll. 15-18). An electric program guide can be selectively displayed on-screen to facilitate viewer program selection (col. 5, ll. 59-62).

3. Neel teaches video enhancing services with optional interactive advertisement capabilities that allow a user to choose to view an advertisement rather than pay for a movie (Fig. 7a).

4. Bee teaches that trailers for movies are considered advertisements.

5. Matthews teaches a subscriber interface unit.

6. Kikinis discloses interactive commercials or advertisements used on the WEB.

PRINCIPLES OF LAW

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

ANALYSIS

Claim 134

The Examiner finds that White teaches the features of claim 134 except “it is silent with respect to the particular provisioning of rental options” (Ans. 4). The Examiner cited Neel as disclosing a media-on-demand system that “enables a plurality of user selectable rental options specific to each one of the plurality of on-demand rentable video presentations.” (Ans. 4) The Examiner states that Appellants’ specification does not clearly provide support for Appellants contention that the rental options are “necessarily separately/independently selectable” (Ans. 4).¹

¹ Although Appellants present arguments (Reply Br. 2-3) with respect to the Examiner’s drawing objection in the Final Rejection (*see* Ans. 12 n.3), such an issue is a petitionable matter – not an appealable matter – and is therefore not before us. *See* MPEP § 706.01 (“[T]he Board will not hear or decide Continued on the next page.

Appellants contend that White “appears to disclose a ‘video-on-demand selection screen’” that includes “a topical listing of movie categories” (Br. 5). Appellants also contend that Neel “at most, appears to disclose a ‘graphics screen [that] asks the user if he or she wants to be billed for the movie or, instead, if they want to watch one or more advertisements and pay for the movie’” (Br. 5). Appellants further argue that Neel fails to suggest the first rental option and the second rental option recited in claim 134. Neel asks the user (via a graphics screen) whether they wish to be billed for the movie or watch one or more advertisements, such that the advertisers will pay for the movie (Br. 8). Thus, Appellants argue nowhere does Neel disclose the first and second rental options.

Neel however discloses that customers are given the option of paying for pay-for-view or on-demand services or having an advertiser pay for the video programming (col. 4, ll. 51-56). Further, Fig. 7a shows the options of: 1) being charged for the movie; or 2) being shown an interactive advertisement and the movie is free. Giving the claims their broadest reasonable interpretation, we agree with the Examiner that Neel’s option 1 serves as both the first and second option of viewing the presentation without any advertisements that would normally be shown (Ans. 14).

issues pertaining to objections and formal matters which are not properly before the Board.”); *see also* MPEP § 1201 (“The Board will not ordinarily hear a question that should be decided by the Director on petition....”).

Furthermore, the Examiner’s contention (Ans. 12) that “separate first and second rental option [sic] are not disclosed in the application” (Ans. 12) and “*would* result in the claims being rejected under 35 U.S.C. 112, 1st paragraph, for containing new matter” (emphasis added) (Ans. 13) is likewise not before us as the Examiner has *not* issued such a rejection.

Although Neel does not mention the usage of movie trailers, Bee allows that trailers are basically advertisements for movies. (Ans. 14). We agree with the Examiner that it would be obvious to combine White and Neel “since choosing to watch a movie without advertisements at a higher price is in essence a selection to forgo the ‘option’ of watching the presentation with both ‘promotional advertisements’ (ex. automobiles) and ‘preceding movie trailers’” (Ans. 15).

We find that Appellants have not persuasively rebutted the Examiner’s prima facie case of obviousness and that all the limitations of claim 134 are taught or suggested by the collective teachings of the cited art.

Claim 135

Claim 135 depends from claim 134. Appellants have provided no arguments with respect to this claim or with respect to Matthews except that it depends from claim 134 and thus, should be allowed.

Since Appellants have not persuaded us of error in the Examiner’s rejection, we find that claim 135 would have been obvious to ordinarily skilled artisans over the collective teachings of the cited art for the reasons presented above with respect to claim 134.

Claims 136-138

Claims 136-138 also depend from claim 134. Again, Appellants provided no arguments with respect to these claims or with respect to the Kikinis reference. Since Appellants have not persuaded us of error in the Examiner’s rejection, we find that claims 136-138 would have been obvious

to ordinarily skilled artisans over the collective teachings of the cited art for the reasons presented above with respect to claim 134.

CONCLUSION

We therefore conclude that the Examiner did not err in rejecting claims 134-138 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner rejecting claims 134-138 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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